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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,755

07/31/2001

Toshihiro Kodaka

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05/31/2006

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EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,755

Applicant(s)

KODAKA ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-15 have been examined. Application 09/917,755 (Method of and apparatus for distributing advertisement) has a filing date 07/31/2001 and foreign priority 03/21/2001.

### *Response to Amendment*

2. In response to Non Final Rejection filed 11/23/2005, the Applicant filed an Amendment on 03/23/2006, which amended claims 1 and 11-15.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber (US 5,855,008).

As per claims 1, 12, 14 and 15, Goldhaber teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a benefit upon purchase of a given commodity and advertisement information in association with said coupon information (see figure 11, column 18, lines 16-35), and

Art Unit: 3622

transmitting said advertisement information to a terminal, which is connected via said network in response to a request from said terminal (see figure 11; column 18, lines 16-35);

*and, as immediate consequence of said transmitting* storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see figure 11; column 18, lines 16-35);

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to a benefit inquiry request for said given commodity from said terminal and indicating the determined benefit to said terminal (see column 18, lines 15-61; column 11, lines 5-32).

As per claim 2, Goldhaber teaches:

A method according to claim 1, wherein the benefit defined by said coupon information represent a discount to be offered upon purchase of the given commodity (see column 11, lines 25-32).

As per claim 3, Goldhaber teaches:

A method according to claim 2, wherein said coupon information represents a discount amount to be offered upon purchase of the given commodity (see column 11, lines 25-32).

As per claim 4, Goldhaber teaches:

A method according to claim 2, wherein said coupon information represents a discount rate to be offered upon purchase of the given commodity (see column 11, lines 25-32).

As per claim 7, Goldhaber teaches:

A method according to claim 1, further comprising the steps of:

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal (see column 11, lines 25-32); and

producing a sales contract for the given commodity with the determined benefit applied, and settling the purchase of the given commodity based on the sales contract (see column 11, lines 25-32; column 18, lines 52-62).

As per claim 8, Goldhaber teaches:

A method according to claim 7, wherein the purchase of the given commodity is settled by asking a banking organization server which can withdraw money from an account of the user of said terminal, to withdraw an amount of money based on the sales contract from the account of the user of said terminal (see column 18, lines 49-60). It is inherent that if a consumer may place an order for specific goods or services, said consumer's account would be debited for said order.

As per claim 9, Goldhaber teaches:

A method according to claim 7, wherein said coupon information represents a condition in which said benefit is applicable, and the benefit defined by said coupon information is applied to the sales contract only when said condition is satisfied upon the purchase of the given commodity (see column 11, lines 25-32).

As per claim 10, Goldhaber teaches:

Art Unit: 3622

A method according to claim 9, wherein said coupon information defines a plurality of benefits which are applicable under different conditions, and one of the benefits which is most advantageous for the user is applied to the sales contract among those benefits whose conditions are satisfied upon the purchase of the given commodity (see column 11, lines 25-32).

As per claim 11, Goldhaber teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a discount amount upon purchase of a given commodity and advertisement information in association with said coupon information, and transmitting said advertisement information to a terminal which is connected via said network in response to a request from said terminal (see figure 11, column 18, lines 15-60);

*and, as immediate consequence of said transmitting* storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see figure 11);

referring to said coupon information stored in association with said terminal and determining a price upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal (see column 11, lines 25-32); and

producing a sales contract for the given commodity with the determined price applied, and settling the purchase of the given commodity based on the sales contract (see column 11, lines 25-32).

As per claim 13, Goldhaber teaches:

A method of browsing through an advertisement distributed over a network, comprising the steps of: acquiring first contents to which advertisement information is related, via said network;

acquiring the advertisement information related to said first contents, from a coupon management server via said network (see figure 11, column 18, lines 15-35);

storing an identifier transmitted from said coupon management server (see column 18, lines 15-35);

*transmitting said first contents and said advertisement information to the terminal which is connected via said network in response to a request from said terminal and, as an immediate consequence of said transmitting, storing first coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see figure 11);*

displaying said first contents and said advertisement information (see figure 11);

acquiring second contents including a list of commodities to which types of *second* coupon information defining a benefit upon the purchase of the commodities are related, via said network (see column 18, lines 15-35);

transmitting said types of *second* coupon information related to the list of commodities included in said second contents and said identifier to said coupon

Art Unit: 3622

management server to acquire usable coupon information from said coupon management server and displaying said second contents and said usable coupon information (see column 18, lines 15-35).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Scroggie (US 5,970,469).

As per claim 5, Goldhaber teaches:

A method according to claim 1, but fails to teach wherein said coupon information represents an expiry date and can be used only prior to said expiry date. However, Scroggie teaches a coupon information which represents expiration date (see Scroggie column 10, lines 20-30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the coupons generated by the Goldhaber's system would include an expiration date, as taught by Scroggie in order to indicate to customers the last date that said coupons would be honored by the manufacturer that issued said coupons.

As per claim 6, Goldhaber teaches:

A method according to claim 5, but fails to teach wherein said coupon information represents a period after which a user is able to use a coupon actually after the user



Art Unit: 3622

has acquired the coupon. However, the same rejection applied to claim 5 regarding this missing limitation is also applied to claim 6.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra  
May 22, 2006



RAQUEL ALVAREZ  
PRIMARY EXAMINER